

Remarks

In the Office Action mailed 02/04/2005, Claims 1-12 are pending in the
 5 application. Claims 1-12 are rejected under 35 USC 103(a) as being unpatentable
 over Doberenz (6,664,556) in view of Seetharaman et al. (6,864,749).

Claims 1-3, 9, and 12 have been canceled. Claims 4, 5, 6, and 10 have been
 amended.

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35 U.S.C. § 103 - OBVIOUSNESS

A *prima facie* case of obviousness is established when the teachings of the
 prior art itself suggest the claimed subject matter to a person of ordinary skill in the
 art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To
 15 establish a *prima facie* case of obviousness, three basic criteria must be met. First,
 there must be some suggestion or motivation, either in the references themselves or in
 the knowledge generally available to one of ordinary skill in the art, to modify the
 reference or to combine reference teachings. Second, there must be a reasonable
 expectation of success. Finally, the prior art reference (or references when combined)
 20 must teach or suggest all the claim limitations. The teaching or suggestion to make
 the claimed invention and the reasonable expectation of success must both be found in
 the prior art, and not based on applicant's disclosure. MPEP § 2142.

When a proposed modification or combination of the prior art would render
 25 the prior art invention unsatisfactory for its intended purpose or change the principle
 of operation of the prior art invention, there is no suggestion or motivation to make
 the proposed modification. As a result, the teachings of the references are not
 sufficient to render the claims *prima facie* obvious. MPEP § 2143.01.

Applicants respectfully submit that the transimpedance amplifier disclosed by Seetharaman *et al.* is inoperative when combined with Doberenz, and thus unsatisfactory. The transimpedance amplifier disclosed by Seetharaman *et al.* is
5 designed for the recovery of high frequency signals, and specifically removes the DC component of the input signal (Abstract, Col 2 lines 50-55). A DC component is required as an input to comparators U402, U401 of Doberenz. Thus the combination is inoperative, and unsatisfactory.

10 The combination of Doberenz and Seetharaman *et al.* do not teach, suggest, or disclose at least the synchronization input as required in amended claim 4, the optical filter as required in amended claim 5, and synchronization of multiple converters as required in amended claims 6, 7, 8, and 11.


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Applicant respectfully suggests that claims 4 - 8 and 10 and 11 are in condition for allowance.

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